

### DETAILED ACTION

Amendment filed on July 9, 2008 has been acknowledged. Claims 3 and 8-10 are pending.

#### ***Response to Amendment***

Rejection of Claim 3 as being unpatentable over Takahashi (US 5037612) in view of Eherts (US 6426048) has been withdrawn in light of applicants' amendments.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 3 and 9-10** are rejected under 35 U.S.C. 102(b) as being anticipated by Eherts (US 6426048).

Eherts teaches a supplying mechanism in an analyzing apparatus for mixing and pipetting liquids. The apparatus comprises a reagent vessel (20) with a reagent fluid solution, a sample vessel (16) provided with a sample fluid solution and a reaction vessel (84) to which the reagent and the sample are supplied. The apparatus further comprises a reagent supplying mechanism (10) and a sample supplying mechanism (10). The apparatus further comprises wherein at least one of the reagent supplying mechanism and the sample supplying mechanism comprises a probe portion (14) for sucking and discharging the reagent fluid solution or the sample fluid solution, a probe arm portion (the portion in Figure 4 from reference number 60 to reference numeral 34)

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including a resin tube (62 or 44) communicated with the probe portion (14) to the reagent vessel (20) and reaction vessel (84). The reagent supplying mechanism further comprises a pump (34) communicated with the probe portion (14) via the resin tube (62 or 44) of the probe arm portion (the portion in Figure 4 from reference number 60 to reference numeral 34). The reagent supplying mechanism further comprises a connection portion (32) connecting the pump (34) to the resin tube (62 or 44). The connection portion (32) includes an enlarged portion having a larger cross sectional area than a cross section area of the resin tube (62 or 44) of the probe arm portion. Additionally, applicants' recite "so as to enable absorption of vibration energy contained in the fluid of the apparatus and to enable inhibition of scattering of a drop of the fluid which is discharged from the probe portion" an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, there is no claimed structural difference between the claimed invention and Eherts and the structure of Eherts is capable of performing the intended use. According to Figure 4, the enlarged portion of the connection portion (32) between the resin tube (62 or 44) extends at an angle of substantially 90 degrees with respect to a horizontal plane. According to Figure 4, the resin tube (62 or 44) of the probe arm portion (the portion in Figure 4 from reference number 60 to reference numeral 34) has a cross-sectional area which is greater than a cross-sectional area of the probe portion (14).

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Eherts.  
Refer above for the teachings of Eherts.

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Eherts fails to explicitly disclose the enlarged portion of the connection portion having the larger cross-sectional area of the resin tube of the probe arm portion has a cross-sectional area which is at least  $5/4$  times and no greater than 10 times the cross-sectional area of the resin tube of the probe arm portion and a length which is at least  $1/1,000$  times and no greater than  $1/10$  times a length of the resin tube of the probe arm portion.

It would have been obvious to one having ordinary skill in the art modify the device of Eherts where the enlarged portion of the connection portion having the larger cross-sectional area of the resin tube of the probe arm portion has a cross-sectional area which is at least  $5/4$  times and no greater than 10 times the cross-sectional area of the resin tube of the probe arm portion and a length which is at least  $1/1,000$  times and no greater than  $1/10$  times a length of the resin tube of the probe arm portion to achieve predictable results of optimal flow through the system. Examiner asserts that Applicant may supply evidence that portions to a criticality of such dimensions that renders such modification unobvious.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 3 and 8-10 have been considered but are moot in view of the new ground(s) of rejection. Refer to the rejection above.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI NAGPAUL whose telephone number is (571)272-1273. The examiner can normally be reached on Monday thru Friday (10:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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JN

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797